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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,262	10/27/2000	Kai Cieliebak	CH919990038USI	7389

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IBM CORPORATION  
INTELLECTUAL PROPERTY LAW DEPT.  
P.O. BOX 218  
YORKTOWN HEIGHTS, NY 10598

EXAMINER


PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/699,262	Applicant(s) CIELIEBAK ET AL.	
	Examiner JAGDISH PATEL	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of claims 1-4 in the reply filed on 5/25/04 is acknowledged. Accordingly claims 5-28 have been canceled. Claims 1-4 are currently pending and have been examined.

### *Claim Objections*

2. Claims 3 and 4 are objected as being in narrative in form and replete with indefinite and functional or operational language. For example, claim 3 recites "the method takes new inputs" "the method is re-executed, by calculating a new efficient frontier which is compared with .." which is a narrative or descriptive form of the method. Instead each process step should be distinctly presented, be a single sentence, and where a claim sets forth a number of elements or steps, each element or step of the claim should be separated by a line indentation.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

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out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4 contain the following deficiencies which renders them indefinite. Appropriate corrections are required to overcome these deficiencies.

Claim 1:

(i) recitation of phrases "such as" (steps a. and b.), optionally (step b.) and "if desired" (conditional limitation of step d.) render the respective steps indefinite since the scope and boundaries of the underlying action is not ascertained with any degree of accuracy.

(ii) Steps b. and c. have no functional relationship to steps a. and d. For example, step d. recites "evaluating performance by comparing the current portfolio and the efficient portfolios with the desired level of risk and return;.." which step can be performed without performing steps b. and c. "optionally, calculating a baseline efficient frontier" and "determining the performance of the current portfolio of SLAs.."

(iii) Step d. recites "evaluating performance" without identifying the function or parameter for which the performance is being evaluated.

5. Note that these deficiencies are also inherited by the dependent claims 2-4.

6. Claim 4 lack proper antecedent basis in the claim because there is no reference of limitation "trading risk " in the parent claim 2 or 1.

Claim 4 is not functionally related to any process step of claim 2. A proper dependent claim must further limit at least

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one process step of the parent claim. In this case the step pf operator determining the number of to-be-traded SLAs of certain class has no functional relationship and/or does not relate to any of steps a.-d. of claim 1 or the claim 2.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michaud et al. (US Pat. 6,003018).

Per claim 1, Michaud discloses a method for evaluating performance of a portfolio (abstract). Michaud teaches calculating efficient frontier that identifies efficient portfolios using a plurality of inputs (see summary of the Invention, col. 2) and evaluating performance by comparing the current portfolio and the efficient portfolio with the desired level of risk and return (specified risk objective, col. 2 L 58-60).

9. Michaud fails to teach that the portfolios are pertaining to SLAs. However, it is noted the difference of the instant

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claim and the prior art is found in the intended use of the claimed method (SLAs versus financial portfolios). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

(Note that the above claim analysis is also based upon the scope of the claim as best understood by the examiner in light of the deficiencies outlined under 35 USC 112(second) .

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Michaud for evaluating a portfolio of SLAs because it would facilitate a optimization of a portfolio of a plurality SLAs with respect to a specified risk objective.

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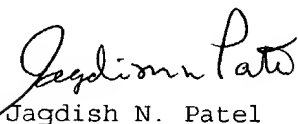
### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

7/20/04